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OFFICE OF PETITIONS

In re Application of :
Light et al. :
Application No. 09/ 759,107 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 2344-001-CIP2 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on October 21, 2004, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of prior- filed nonprovisional Application 09/265,656 filed March 2, 1999.

The petition is **Dismissed**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition must accompanied by:

(1) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence following the title. *See* 35 USC 120 and 37 CFR 1.78(a)(2);

(2) the surcharge as set forth in 37 CFR 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior filed applications in the amendment to the specification has been filed with the instant petition. However the amendment is not acceptable as drafted since it improperly incorporates by reference the prior filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew distinction between a permissible 35 U.S.C. §120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The Court specifically stated:

> Section 120 merely provides the mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation by reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. *In re deSeversky*, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See In re deSeversky*, *supra*. Note also MPEP 201.06(c).

It is noted the specification supplied on filing did include an incorporation by reference statement to application 08/963,373. However, the incorporation by reference statement referencing 09/265,656 is not appropriate.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted , a substitute

amendment[1] deleting the incorporation by reference statement as it applies to 09/265,656, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this matter may be directed to Petition Attorney Charlema R. Grant at 571.272- 3215.

Charles Pearson
Director
Office of Petitions

[1]Note 37 CFR 1.121 and 37 CFR 1.116